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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,006	02/07/2002	Lewis M. Fetterman	701-01	8858

7590 07/29/2004

Robert Rosenthal
Suite 200
5856 Faringdon Place
Raleigh, NC 27609

EXAMINER

BARRY, CHESTER T

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/071,006

Applicant(s)

FETTERMAN ET AL.

Examiner

Chester T. Barry

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 19.Claim(s) objected to: 13-16.Claim(s) rejected: 6-12, 17, 18 and 20.Claim(s) withdrawn from consideration: 1-5.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Chester T. Barry
571-272-1152 direct
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The expression swine "solids" implies a "moisture free basis." The application does not state the moisture content of the "carbon source," but a relatively low, i.e., nominal to bone dry, moisture content would have been expected by the skilled artisan absent an express definition in the specification. Accordingly, the new limitation of a mixture moisture content of about 60% introduces a new 112(2nd) issue: In claim 8, for example, 40% vol. swine solids + 40% (mass implied) carbon source + about 60% weight moisture adds up to over 100%. Accordingly, the skilled artisan is not on fair notice of the claimed scope at least because a) it is unclear what the specific volume (volume per unit mass) of applicant's swine solids is and b) it is unclear whether swine solids (vol %) are measured on a bone dry / crushed powder, bone dry / porous, or moist basis. This point applies to claims 8, 11, 12, 14, 15, 16, and 20. It is a "new issue" raised by applicant's "new limitation" and which does not simplify issues on appeal.

Furthermore, the shift in subject matter from "sand" to "clay" in claim 17 introduces a new limitation requiring further search. In his remarks accompanying the after final amendment, Applicant points to specification page 9 lines 21-22 for support for the notion that "unwashed sand often includes clay." This observation is beside the point. Claim 18 on April 19, 2004, required the addition of sand and clay. Claim 17 as proposed requires only the addition of clay. The broadening of the claim in this respect requires a new search and further consideration. That is, claim 17 as proposed does not require the addition of any sand.

Of the 112 rejections made in the Final rejection of April 19, the following rejections are overcome by the proposed amendment:

Claim 6 line 2 "improved," and

Claim 20 "prepared by the process . . . the step of"

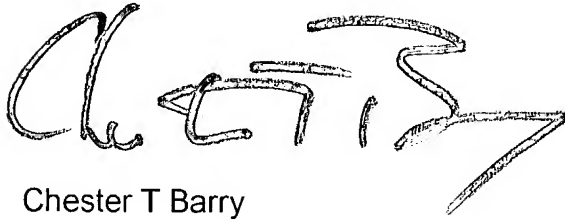
Applicant's remarks at page 8 line 5 of the response filed 6/24/04 (i.e., "as for the substantive portion of the Office action") implies that rejections under 35 USC Sec. 112, second paragraph, do not constitute a substantive portion of an Office action. The examiner does not agree with applicant's characterization. The examiner believes that Sec. 112, 2nd paragraph serves an important notice function. See, for example, MPEP 2173.

Applicant's arguments urging allowance of claims rejected over art were carefully considered, but not persuasive. There is no requirement that a reference must describe subject matter "in of itself" to be an available prior art teaching: An enabling description of the subject matter is sufficient for 102/103 purposes.

Examiner's note: The rejection of claim 18 based on the closed language of claim 17 and the "further including . . . adding clay" language of claim 18 could have been avoided altogether had claim 18 recited a wherein clause rather than a "further including" clause. For example, claim 18 could have been drafted as, "wherein said

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sand is unwashed sand comprising clay." Such language would not have involved an additional step of adding clay, but rather narrowing the scope of the material added by the "mixing" step of claim 17.

A handwritten signature in black ink, appearing to read 'Chester T Barry'. The signature is stylized with large, sweeping loops and a prominent 'C' at the beginning.

Chester T Barry

571-272-1152